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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,653	03/15/2004	Tomoko Kimura		8582

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MATTINGLY, STANGER & MALUR, P.C.
Suite 370
1800 Diagonal Road
Alexandria, VA 22314

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/799,653

Applicant(s)

KIMURA ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/15/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/15/2004, 10/6/2004, & 12/19/2005.

DETAILED ACTION

Claims 42-46 have been examined.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is 169 words long, exceeding the permitted length. Correction is required. See MPEP § 608.01(b).

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 44 is objected to because of the following informalities: The comma at the end of the eleventh line should be a semicolon. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al. (U.S. Patent 5,845,281) in view of official notice. Benson discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of the digital contents (column 3, lines 44-61; column 9, lines 11-59); storing, in a digital contents personal using condition management table, a digital contents personal using condition including identification information of said digital contents and information of personal using conditions of said digital contents to said user (column 3, lines 44-61;

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column 9, line 61, through column 10, line 52); in response to a request from the user, reading said digital contents personal using condition corresponding to the user from the digital contents personal using condition management table, in order to generate a personal condition list based on the digital contents personal using condition read from the digital contents personal using condition management table (column 3, line 44, through column 4, line 4; column 5, lines 30-41; column 10, lines 11-22); generating a personal using condition list based on said digital contents personal using condition read from the digital contents personal using condition management table (column 3, lines 44-61; column 7, line 33, through column 8, line 26); and transmitting a personal using condition list to the user via the network (column 8, lines 21-26; column 12, line 29, through column 13, line 4). Benson does not disclose a list page, as such, but the disclosed list of control data specifying personal using conditions could be considered a list; if not, official notice is taken that it is well known for data to be listed on list pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the personal using condition list to be a list page, for at least the obvious advantage of making it easy to bring up and read the personal using condition information listed.

Benson does not expressly disclose that the reading of the digital contents personal using condition is in response to an input of identification information of the user, but does disclose that a user request to purchase rights to digital contents includes identification (column 13, lines 29-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention

for the reading of the digital contents personal using condition to be in response to an input of identification information of the user, for the obvious advantages of enabling a personal using conditions to be generated and applied based on the user's identity, as disclosed by Benson, and enabling a personalized data package to be transmitted, mailed, or otherwise delivered to the correct user, also as disclosed by Benson.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al. (U.S. Patent 5,845,281) in view of official notice. Benson discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of the digital contents (column 3, lines 44-61; column 9, lines 11-59); storing, in a digital contents personal using condition management table, a digital contents personal using condition including identification information of said digital contents and information of personal using conditions of said digital contents to said user (column 3, lines 44-61; column 9, line 61, through column 10, line 52); in response to a request from the user, reading said digital contents personal using conditions corresponding to the user from the digital contents personal using condition management table, in order to generate a personal condition list based on the digital contents personal using condition read from the digital contents personal using condition management table (column 3, line 44, through column 4, line 4; column 5, lines 30-41; column 10, lines 11-22); generating a personal using condition list based on said digital contents personal using condition

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read from the digital contents personal using condition management table (column 3, lines 44-61; column 7, line 33, through column 8, line 26); and transmitting a personal using condition list to the user via the network (column 8, lines 21-26; column 12, line 29, through column 13, line 4). Benson does not disclose a list page, as such, but the disclosed list of control data specifying personal using conditions could be considered a list; if not, official notice is taken that it is well known for data to be listed on list pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the personal using condition list to be a list page, for at least the obvious advantage of making it easy to bring up and read the personal using condition information listed.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al. (U.S. Patent 5,845,281) in view of official notice. Benson discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of the digital contents (column 3, lines 44-61; column 9, lines 11-59); storing, in a digital contents personal using condition management table, a digital contents personal using condition including identification information of said digital contents and information of personal using conditions of said digital contents to said user (column 3, lines 44-61; column 9, line 61, through column 10, line 52); reading said digital contents personal using conditions corresponding to the user from the digital contents personal using

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condition management table (ibid.); generating a personal using condition list based on said digital contents personal using condition read from the digital contents personal using condition management table (column 3, lines 44-61; column 7, line 33, through column 8, line 26); and transmitting a personal using condition list to the user via the network (column 8, lines 21-26; column 12, line 29, through column 13, line 4). Benson does not disclose a list page, as such, but the disclosed list of control data specifying personal using conditions could be considered a list; if not, official notice is taken that it is well known for data to be listed on list pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the personal using condition list to be a list page, for at least the obvious advantage of making it easy to bring up and read the personal using condition information listed.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al. (U.S. Patent 5,845,281) in view of Haff et al. (U.S. Patent 6,21,9,669) and official notice. Benson discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of the digital contents (column 3, lines 44-61; column 9, lines 11-59); storing, in a digital contents personal using condition management table, a digital contents personal using condition including identification information of said digital contents and information of personal using conditions of said digital contents to said user (column 3, lines 44-61; column 9, line 61, through column 10, line 52);

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transmitting digital contents corresponding to identification information to the user (column 3, line 44, through column 4, line 8; column 8, lines 4-26); in response to a request from the user, reading said digital contents personal using condition corresponding to the user from the digital contents personal using condition management table, in order to generate a personal condition list based on the digital contents personal using condition read from the digital contents personal using condition management table (column 3, line 44, through column 4, line 4; column 5, lines 30-41; column 10, lines 11-22); generating a personal using condition list based on said digital contents personal using condition read from the digital contents personal using condition management table (column 3, lines 44-61; column 7, line 33, through column 8, line 26); and transmitting a personal using condition list to the user via the network (column 8, lines 21-26; column 12, line 29, through column 13, line 4). Benson does not disclose a list page, as such, but the disclosed list of control data specifying personal using conditions could be considered a list; if not, official notice is taken that it is well known for data to be listed on list pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the personal using condition list to be a list page, for at least the obvious advantage of making it easy to bring up and read the personal using condition information listed.

Benson does not expressly disclose that the reading of the digital contents personal using condition is in response to an input of identification information of the user, but does disclose that a user request to purchase rights to digital contents includes identification (column 13, lines 29-51). Hence, it would have been obvious to

one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the reading of the digital contents personal using condition to be in response to an input of identification information of the user, for the obvious advantages of enabling a personal using condition to be generated and applied based on the user's identity, as disclosed by Benson, and enabling a personalized data package to be transmitted, mailed, or otherwise delivered to the correct user, also as disclosed by Benson.

Benson does not disclose receiving from the user via the network a request for retransmitting one of the digital contents displayed in the personal using condition list page, and retransmitting the digital contents requested, if the digital contents personal using condition corresponding to the digital contents requested is valid. However, Haff teaches receiving from a user or the user's computer a request for retransmitting one of digital contents, and retransmitting the digital contents requested (column 7, lines 7-15; column 28, lines 14-26), while Benson, as above, discloses transferring contents if the personal using conditions are valid. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such a request and retransmit the digital contents requested, if the corresponding personal using condition is valid, for the obvious and implied advantage of providing digital contents to recipients who are supposed to receive them, in the case of difficulties having arisen in transmission.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benson et al. (U.S. Patent 5,845,281) in view of Haff et al. (U.S. Patent 6,21,9,669) and official

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notice. Benson discloses a digital contents sales method for selling digital contents in a digital contents sales apparatus for transmitting the digital contents to a user via a network, the method comprising the steps of: receiving, from a user via the network, an input for indicating purchase of the digital contents (column 3, lines 44-61; column 9, lines 11-59); storing, in a digital contents personal using condition management table, a digital contents personal using condition including identification information of said digital contents, in which a physical act restriction is built, and information of personal using conditions of said digital contents to said user (column 3, lines 44-61; column 9, line 61, through column 10, line 52; column 15, lines 1-14 [for the physical act restriction]); transmitting digital contents corresponding to identification information to the user (column 3, line 44, through column 4, line 8; column 8, lines 4-26); in response to a request from the user, reading said digital contents personal using condition corresponding to the user from the digital contents personal using condition management table, in order to generate a personal condition list based on the digital contents personal using condition read from the digital contents personal using condition management table (column 3, line 44, through column 4, line 4; column 5, lines 30-41; column 10, lines 11-22); generating a personal using condition list based on said digital contents personal using condition read from the digital contents personal using condition management table (column 3, lines 44-61; column 7, line 33, through column 8, line 26); and transmitting a personal using condition list to the user via the network (column 8, lines 21-26; column 12, line 29, through column 13, line 4). Benson does not disclose a list page, as such, but the disclosed list of control data specifying

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personal using conditions could be considered a list; if not, official notice is taken that it is well known for data to be listed on list pages. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the personal using condition list to be a list page, for at least the obvious advantage of making it easy to bring up and read the personal using condition information listed.

Benson does not expressly disclose that the reading of the digital contents personal using condition is in response to an input of identification information of the user, but does disclose that a user request to purchase rights to digital contents includes identification (column 13, lines 29-51). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the reading of the digital contents personal using condition to be in response to an input of identification information of the user, for the obvious advantages of enabling a personal using condition to be generated and applied based on the user's identity, as disclosed by Benson, and enabling a personalized data package to be transmitted, mailed, or otherwise delivered to the correct user, also as disclosed by Benson.

Benson does not disclose receiving from the user via the network a request for retransmitting one of the digital contents displayed in the personal using condition list page, and retransmitting the digital contents requested, if the digital contents personal using condition corresponding to the digital contents requested is valid. However, Haff teaches receiving from a user or the user's computer a request for retransmitting one of digital contents, and retransmitting the digital contents requested (column 7, lines 7-15; column 28, lines 14-26), while Benson, as above, discloses transferring contents if the

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personal using conditions are valid. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to receive such a request and retransmit the digital contents requested, if the corresponding personal using condition is valid, for the obvious and implied advantage of providing digital contents to recipients who are supposed to receive them, in the case of difficulties having arisen in transmission.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rose (U.S. Patent 5,708,709) discloses a system and method for managing a try-and-buy usage of application programs. Krishnan et al. (U.S. Patent 6,073,124) disclose a method and system for securely incorporating electronic information into an online purchasing application.

Erickson (WO 97/14087 A1) and Anand et al. (EP 0813 133 A2) are the most pertinent foreign patent documents of record, both having been made of record by Applicant.

The BuyDirect.com "Help" article is the most pertinent non-patent literature document of record, also having been made of record by Applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen

**NICHOLAS D. ROSEN
PRIMARY EXAMINER**

April 17, 2007